



Atty. Dkt. No. 053466-0296

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tadamitsu KISHIMOTO et al.

Title: CHRONIC RHEUMATOID ARTHRITIS
THERAPY CONTAINING IL-6 ANTAGONIST
AS EFFECTIVE COMPONENT

Appl. No.: 09/756,125

Filing Date: 1/9/2001

Examiner: Gerald R. EWOLDT

Art Unit: 1644

Conf. No.: 6506

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Your Petitioners, CHUGAI SEIYAKU KABUSHIKI KAISHA and TADAMITSU KISHIMOTO, of 5-1 Ukima 5-chome, Kita-ku, Tokyo, Japan, and 3-5-31, Nakano-cho, Tondabayashi-shi, Osaka, Japan, respectively, represent that they are the joint owners of the entire right, title, and interest in and to U.S. Patent Application Serial No. 09/756,125, filed 1/9/2001, by virtue of an Assignment filed and recorded on 4/7/1997, on Reel/Frame 8525/0517, in prior U.S. Patent Application No. 08/817,084 (now U.S. 5,888,510) in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A.

Further, your Petitioner represents that they are the joint owners of U.S. Patent Application No. 11/585,172, filed October 24, 2006, which is a continuation of U.S. Patent Application Serial No. 08/817,507, filed October 20, 1995 as the U.S. National Stage of PCT/JP2005/02169, by virtue of an Assignment filed and recorded on April 17, 1997, on

07/15/2010 AWONDAF1 00000054 09756125

Reel/Frame unknown, in U.S. Patent Application Serial No. 08/817,507 in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX B.

Your Petitioners, CHUGAI SEIYAKU KABUSHIKI KAISHA and TADAMITSU KISHIMOTO, hereby disclaim the terminal part of the term of any patent granted on U.S. Patent Application 09/756,125 which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of any patent granted on U.S. Patent Application 11/585,172, and hereby agree that any patent so granted on U.S. Patent Application 09/756,125 shall be enforceable only for and during such period that any patent granted on U.S. Patent Application 11/585,172 and any patent granted on U.S. Patent Application 09/756,125 are commonly owned, this agreement to run with any patent granted on U.S. Patent Application 09/756,125 and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioners do not disclaim any terminal part of any patent granted on U.S. Patent Application 09/756,125, prior to the full statutory term of any patent granted on U.S. Patent Application 11/585,172 as defined in 35 U.S.C. §§154-156 and 173, in the event that any patent granted on U.S. Patent Application 11/585,172 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of any patent granted on U.S. Patent Application 11/585,172 as defined in 35 USC §§154-156 and 173, except for lack of common ownership as stated above. Further, Petitioners do not disclaim any terminal part of a patent granted on U.S. Patent Application 09/756,125 that would extend beyond the present termination of any patent granted on U.S. Patent Application 11/585,172, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioners' right to extend the term of a patent granted on U.S. Patent Application 09/756,125 to the extent provided by law.

The undersigned, being the Attorney of Record for U.S. Patent Application 09/756,125, and duly authorized to act on behalf of Petitioners, certifies that he has reviewed the Assignments attached as APPENDICES A and B, and to the best of his knowledge and belief, ownership of U.S. Patent Application 09/756,125 and any patent granted on U.S. Patent Application 11/585,172 rests with Petitioners, CHUGAI SEIYAKU KABUSHIKI KAISHA and TADAMITSU KISHOMOTO. The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date 14 July 2010

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

By S. A. Bent, Reg #29768
for Stephen B. Maebius
Attorney for Applicant
Registration No. 35,264



APPENDIX A



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Assignments on the Web > Patent Query

Patent Assignment Abstract of Title

NOTE: Results display only for issued patents and published applications.
For pending or abandoned applications please consult USPTO staff.

Total Assignments: 1

Patent #: [5888510](#) **Issue Dt:** 03/30/1999 **Application #:** 08817084 **Filing Dt:** 04/07/1997

Inventors: TADAMITSU KISHIMOTO, MASAHIKO MIHARA, YOICHIRO MORIYA, YOSHIYUKI OHSUGI

Title: CHRONIC RHEUMATOID ARTHRITIS THERAPY CONTAINING IL-6 ANTAGONIST AS EFFECTIVE COMPONENT

Assignment: 1

Reel/Frame: [008525/0517](#) **Recorded:** 04/07/1997 **Pages:** 3

Conveyance: ASSIGNMENT OF ASSIGNEES INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors: [KISHIMOTO, TADAMITSU](#) **Exec Dt:** 03/28/1997

[MIHARA, MASAHIKO](#) **Exec Dt:** 03/28/1997

[MORIYA, YOICHIRO](#) **Exec Dt:** 03/28/1997

[OHSUGI, YOSHIYUKI](#) **Exec Dt:** 03/28/1997

Assignees: [CHUGAI SEIYAKU KABUSHIKI KAISHA](#)

5-1, UKIMA 5-CHOME, KITA-KU

TOKYO, JAPAN 115

[KISHIMOTO, TADAMITSU](#)

3-5-31, NAKANO-CHO, TONDABAYASHI-SHI

OSAKA, JAPAN 584

Correspondent: FOLEY & LARDNER

HAROLD C. WEGNER

3000 K STREET, N.W.

SUITE 500

WASHINGTON, DC 20007-5109

Search Results as of: 07/13/2010 10:19 AM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350.

Web interface last modified: October 18, 2008 v.2.0.2

| [HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

APPENDIX B

OPAP
JUL 14 2000
RECORDATION FORM COVER SHEET
PATENT & TRADEMARK OFFICE

PATENTS ONLY

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Tadamitsu KISHIMOTO, Asao KATSUME and Hiroyuki SAITO

Additional name(s) of conveying party(ies) attached? No

3. Nature of conveyance:

<input checked="" type="checkbox"/> Assignment	— Merger
<input type="checkbox"/> Security Agreement	— Change of Name
<input type="checkbox"/> Other _____	

Execution Date: April 2, 1997

2. Name and address of receiving party(ies):

Name: TADAMITSU KISHIMOTO

Internal Address:

Street Address: 3-5-31, Nakano-cho, Tondabayashi-shi

City: Osaka, State: Japan ZIP:

Additional name(s) & address(es) attached? Yes

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: April 2, 1997

A. Patent Application No.(s)

B. Patent No.(s)

Additional numbers attached? No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Harold C. Wegner

Internal Address: FOLEY & LARDNER

Street Address: 3000 K Street, N.W., Suite 500

City: Washington, State: D.C. ZIP: 20007-5109

6. Total number of applications and patents involved: 1

7. Total fee (37 C.F.R. § 3.41). \$40.00

Enclosed

Authorized to be charged to deposit account

8. Deposit account number: 19-0741

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Harold C. Wegner

Name of Person Signing

Signature

April 17, 1997

Date

Total number of pages including cover sheet, attachments, and document: 3

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

ATTACHMENT TO BOX 2

2. Name and address of receiving party(ies):

Name: **CHUGAI SEIYAKU KABUSHIKI KAISHA**

Internal Address:

Street Address: **5-1, Ukima 5-chome, Kita-ku**

City: **Tokyo**, State: **Japan** ZIP:

Additional name(s) & address(es) attached? **No**

U.S. ASSIGNMENT

IN CONSIDERATION of the sum of One Dollar (\$1.00), and of other good and valuable consideration paid to the undersigned inventor(s) (hereinafter "ASSIGNOR") by

(Insert
ASSIGNEE's
Name(s)
Address(es))

1) Tadamitsu Kishimoto

3-5-31, Nakano-cho, Tondabayashi-shi, Osaka, Japan

2) CHUGAI SEIYAKU KABUSHIKI KAISHA

5-1, Ukimura 5-chome, Kita-ku, Tokyo, Japan

(hereinafter "ASSIGNEE"), the receipt of which is hereby acknowledged, the undersigned ASSIGNOR hereby sells, assigns and transfers to ASSIGNEE the entire and exclusive right, title and interest to the invention entitled

(Title of
Invention)

PHARMACEUTICAL COMPOSITION FOR TREATMENT OF DISEASES CAUSED
BY IL-6 PRODUCTION

relating to International Patent Application PCT/JP 95 / 02169 and/or for which application for Letters Patent of the United States was executed on even date herewith or, if not so executed, was:

(Insert date
of execution
of application,
if not
concurrent)

(a) executed on _____;

(_____

_____)

(b) filed on _____;
Serial No. _____ / _____;

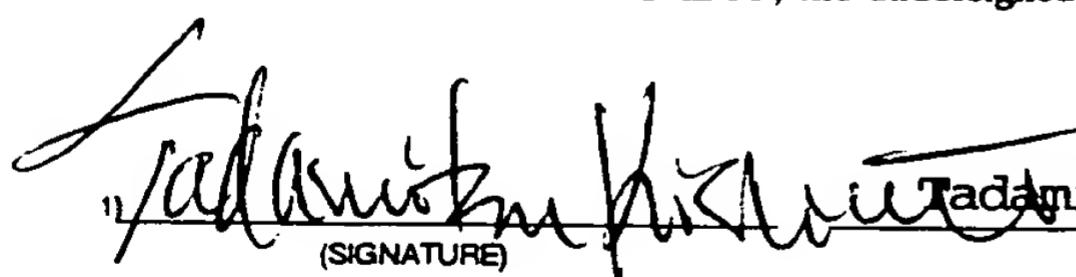
) is hereby authorized to insert in (b) the specified
data, when known.

and to said application and all Letters Patent(s) of the United States granted on said application and any continuation, division, renewal, substitute, reissue or reexamination application based thereon, for the full term or terms for which the said Letters Patent(s) may be granted and including any extensions thereof (collectively, hereinafter, "said application(s) and Letters Patent(s)").

The ASSIGNOR agree(s), when requested by said ASSIGNEE and without charge to but at the expense of said ASSIGNEE, to do all acts which the ASSIGNEE may deem necessary, desirable or expedient, for securing, maintaining and enforcing protection for said invention, including in the preparation and prosecution of said application(s) and the issuance of said Letters Patent(s), in any interference, reissue, reexamination, or public use proceeding, and in any litigation or other legal proceeding which may arise or be declared in relation to same, such acts to include but not be limited to executing all papers, including separate assignments and declarations, taking all rightful oaths, providing sworn testimony, and obtaining and producing evidence.

IN WITNESS WHEREOF, the undersigned inventor(s) has (have) affixed his/her/their signature(s).

(Signatures)

1)  Tadamitsu Kishimoto April 2, 1997
(SIGNATURE) (TYPE NAME) (DATE)

2)  Asao Katsume April 2, 1997
(SIGNATURE) (TYPE NAME) (DATE)

3)  Hiroyuki Saito April 2, 1997
(SIGNATURE) (TYPE NAME) (DATE)

4) _____
(SIGNATURE) (TYPE NAME) (DATE)

5) _____
(SIGNATURE) (TYPE NAME) (DATE)

6) _____
(TYPE NAME) (DATE)